



**UNITED STATES DEPARTMENT OF COMMERCE
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S.R.

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/490,370 01/24/00 KOERBLE

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EXAMINER

QM12/1221

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Owatonna MN 55060

DEXTER C

ART UNIT

PAPER NUMBER

3724
DATE MAILED:

#2

12/21/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/490,370

Applicant(s)
Koerble et al.

Examiner
Clark F. Dexter

Group Art Unit
3724



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-4 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-4 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Oath/Declaration

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

(a) It does not identify the citizenship of the second inventor.

Further, clarification is requested for the following:

(a) The surname of the second inventor is unclear. Is the second inventor's last name "Hoegler Koerble" or just "Koerble"?

(b) The residence/post office address of the first inventor is unclear. Is it accurate that the first inventor has a Wisconsin post office address, but is a resident of Minnesota? It is noted that this does not agree with page 1 of the specification which states that the first inventor is a resident of Wisconsin.

Drawings

2. The drawings are objected to because it is not clear as to what the assembled invention looks like. A figure or figures should be added (e.g., on additional drawing sheets) showing at least one additional view of the assembled device which best illustrates the device; for example, it

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is suggested to provide an perspective view of the device only; and either or both of a side view of the device interacting with a work piece, and a view of the device on a band saw and interacting with the work piece. Care should be taken so that no new matter is added (note: "new matter" includes subject matter which is not supported by the originally filed application).

Specification

3. The disclosure is objected to because of the following informalities:

A specific description has not been provided for each of elements 10, 11, 12 and 13.

Appropriate correction is required.

Claim Rejections - 35 USC § 112, 1st paragraph

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of 37 CFR 1.71(a)-(c):

(a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

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(c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

The specification is objected to under 37 CFR 1.71 because, in general, it is not clear how the invention is constructed or how it operates. Clarification is required. Care should be taken so that no new matter is added (it is again noted that "new matter" includes subject matter which is not supported by the originally filed application).

Claim Rejections - 35 USC § 112, 2nd paragraph

5. Claims 1-4 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claims are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device or the steps which go to make up the process must be clearly and positively specified. The structure or steps must be organized and correlated in such a manner as to present a complete operative device or process, respectively. The claims must be in one sentence form only. Note the format of the claims in the patent(s) cited. Further, applicants' claims are unclear as to what statutory class of invention is being claimed (i.e., method of using, method of making, apparatus, etc).

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Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 2 and 4, as understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Woods, pn 4,658,686.

Woods discloses the claimed process as best understood from the claims.

8. Claims 1-3, as understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Masuy, pn 2,597,355.

Masuy discloses the claimed process as best understood from the claims.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark Dexter whose telephone number is (703) 308-1404.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Rinaldi Rada, can be reached at (703)308-2187.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-1148. The fax numbers for this group are: formal papers - (703)305-3579; informal/draft papers - (703)305-9835.

A handwritten signature in black ink, appearing to read 'Clark F. Dexter', written in a cursive style.

Clark F. Dexter
Primary Examiner
Art Unit 3724

cf
December 15, 2000